



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/790,386	03/01/2004	David S. Lerner	QMT-2R CA	1100
3775	7590	11/02/2005	EXAMINER	
ELMAN TECHNOLOGY LAW, P.C. P. O. BOX 209 SWARTHMORE, PA 19081-0209			LAMM, MARINA	
			ART UNIT	PAPER NUMBER
			1616	

DATE MAILED: 11/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/790,386

Applicant(s)

LERNER, DAVID S.

Examiner

Marina Lamm

Art Unit

1616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 February 2005 and 05 August 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,2,4-9 and 13-30 is/are pending in the application.
- 4a) Of the above claim(s) 1,2,4-9,25 and 30 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 13-24 and 26-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 2/28/05
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election of Group II, Claims 13-23, in the reply filed on 2/28/05 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).
2. Applicant's election of species in the reply filed on 8/5/05 is acknowledged. The elected species are Ilomastat (MMPI) and a plant extract comprising triterpene glycoside (estrogen or phytoestrogen).
3. Claims pending are 1, 2, 4-9 and 13-30. Claims 24-30 are new. Claims 1, 2, 4-9, 25 and 30 have been withdrawn from consideration as directed to non-elected invention and/or species. Claims 13-24 and 26-29 are being examined on the merits.

### ***Double Patenting***

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Art Unit: 1616

5. Claims 13, 17, 19-21, 23, 24 and 26-29 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4 of U.S. Patent No. 6,713,074 ('074). An obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but an examined application claim is not patentably distinct from the reference claim(s) because the examined claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985). Although the conflicting claims are not identical, they are not patentably distinct from each other because the presently claimed invention overlaps with that previously claimed. Specifically, claims 1-4 of '074 are directed to a composition for using in the method claimed in the instant claims. The method claims of the instant invention are obvious over the claims directed to a composition for using in such method because the composition0 claims of '074 recite the use claimed herein. A double patenting rejection of the obviousness-type is "analogous to [a failure to meet] the nonobviousness requirement of 35 U.S.C. 103" except that the patent principally underlying the double patenting rejection is not considered prior art. *In re Braithwaite*, 379 F.2d 594, 154 USPQ 29 (CCPA 1967). Therefore, any analysis employed in an obviousness-type double patenting rejection parallels the guidelines for analysis of a 35 U.S.C. 103 obviousness determination. *In re Braat*, 937 F.2d 589, 19

Art Unit: 1616

USPQ2d 1289 (Fed. Cir. 1991); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985). See MPEP 804 (II) (B) (1).

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 13, 14-18, 22, 24, 26 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maybeck et al. (US 5,747,538) in view of Fleischmajer (US 2002/0010162) and Carson et al. (US 6,270,780), all of record.

Maybeck et al. teach cosmetic compositions and method for combating effects of actinic or chronological skin aging, stimulating collagen synthesis, firming and healing the skin, such composition containing triterpene glycoside (ginsenoside) in a cosmetically acceptable carrier. See Abstract; col. 2, lines 49-55; col. 3, lines 15-40, col. 4, lines 3-9, 46-65; col. 8, Example 7. The compositions of Maybeck et al. are applied to the skin twice a day for an extended period of time (e.g. 4 weeks). See Examples 5, 6. Maybeck et al. does not teach the claimed matrix metalloproteinase inhibitor ("MMPI"), Ilomastat. However, Fleischmajer teaches using MMPIs, including Ilomastat, for the treatment of psoriasis. See [0023]; [0026]; [0040]. It appears that MMPIs are capable of controlling (inhibiting) keratinocyte proliferation and migration. See [0066]-[0077]. Further, Carson et al. teach that inhibition of keratinocyte proliferation and stimulation

Art Unit: 1616

of keratinocyte differentiation results in improved appearance of the aged skin. See Abstract; col. 1, lines 19-41. Therefore, it would have been *prima facie* obvious to one having ordinary skill in the art at the time the invention was made to modify the anti-aging compositions of Maybeck et al. such that to employ MMPis, including Ilomastat. One having ordinary skill in the art would have been motivated to do this to obtain an additional keratinocyte proliferation inhibiting effect, and thus anti-aging effect, as suggested by Fleischmajer and Carson et al. With respect to Claims 15 and 16, Carson et al. teach using UVA and UVB sunscreens in anti-aging skin compositions in order to protect the skin from the sun's UV radiation. See col. 5, lines 36-47. Therefore, it would have been *prima facie* obvious to one having ordinary skill in the art at the time the invention was made to further modify the anti-aging compositions of Maybeck et al. such that to employ UVA and/or UVB sunscreens. One having ordinary skill in the art would have been motivated to do this to protect the skin from the sun's UV radiation as suggested by Carson et al. It would have been *prima facie* obvious to one having ordinary skill in the art at the time the invention was made to apply these compositions before sunlight exposure for the maximum beneficial effect of the sunscreens.

8. Claims 19-21 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maybeck et al. (US 5,747,538) in view of Fleischmajer (US 2002/0010162) and Carson et al. (US 6,270,780), and further in view of Billek ("Cosmetics for Elderly People", Cosmetics & Toiletries Magazine, Vol. 111, July 1996, pp. 31-37).

Maybeck et al. in view of Fleischmajer and Carson et al. applied as above. With respect to Claims 19-21, neither reference specifically teaches the claimed patient population. However, it is well known that skin aging affects both men and women after certain age, most significantly after age of 30. See Billek @ Table 1-1 on p. 31. Therefore, it would have been *prima facie* obvious to one having ordinary skill in the art at the time the invention was made to use anti-aging skin compositions of Maybeck et al. in view of Fleischmajer for men as well as for pre- and post-menopausal women because these groups are most significantly affected with signs of intrinsic skin aging. With respect to Claim 23, Billek teaches that lifestyle choices such as smoking, promote the skin aging process. See p. 31. Therefore, the recitation of "adverse effects of smoking or smoke exposure on skin" would include skin aging taught by Maybeck et al.

9. Claims 27 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maybeck et al. (US 5,747,538) in view of Fleischmajer (US 2002/0010162) and Carson et al. (US 6,270,780), and further in view of Mohammadi et al. (US 6,649,178).

Maybeck et al. in view of Fleischmajer and Carson et al. applied as above. Neither reference teaches the black cohosh extract of the instant claims. However, Mohammadi et al. teach using black cohosh extract in cosmetic compositions as anti-irritant to reduce skin inflammation. See col. 3, line 5-6, 23. Therefore, it would have been *prima facie* obvious to one having ordinary skill in the art at the time the invention was made to further modify the anti-aging compositions of Maybeck et al. such that to employ black cohosh extract. One having ordinary skill in the art would have been

motivated to do this to obtain an additional skin soothing and anti-inflammatory effect as suggested by Mohammadi et al.

Therefore, the invention as a whole would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made.

### ***Conclusion***

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US 6,800,292.

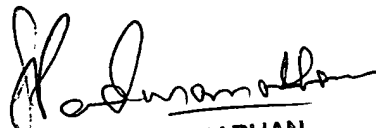
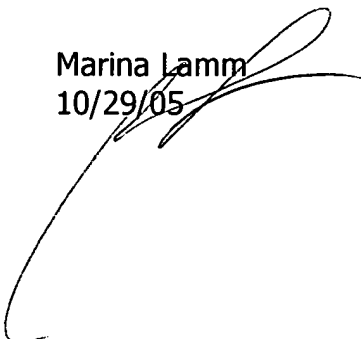
11. No claim is allowed at this time.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marina Lamm whose telephone number is (571) 272-0618. The examiner can normally be reached on Mon-Fri from 11am to 5pm.

The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Marina Lamm  
10/29/05



SREENI PADMANABHAN  
SUPERVISORY PATENT EXAMINER